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PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2673**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Yasuo YAMAMOTO et al.

Group Art Unit: 2673

Application No.: 09/963,546

Examiner: N. Patel

Filed: September 27, 2001

Docket No.: 110704

For: IMAGE DISPLAY MEDIUM AND IMAGE FORMING APPARATUS

REQUEST FOR RECONSIDERATION

RECEIVED

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AUG 03 2004

Technology Center 2600

Sir:

In reply to the June 17, 2004 Office Action, reconsideration of the rejection is respectfully requested in light of the following remarks.

Claims 1-9 are pending in this application.

The courtesies extended to Applicants' representative by Examiner Patel during the telephone interview held July 26, 2004, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicants' record of the interview.

I. Rejection Under 35 U.S.C. §102(e)

Claims 1-4 and 9 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,113,810 (hereinafter Hou). This rejection is respectfully traversed.

The Patent Office alleges that Hou shows an image displaying medium that comprises a charge controller that is internally added to one or both of the particles. Applicants respectfully disagree.

Hou describes an electrophoretic dispersion comprising a dielectric fluid, a set of first color particles having a selected polarity and a set of second particles having a polarity opposite that of the first set of color particles. See the Abstract. It is clear that the charge controller in Hou is external to the particle as it is added to the dispersion fluid, i.e., to the dielectric fluid. See the last sentence of the Abstract and col. 6, lines 7-9 of Hou. Hou teaches that each set of particles is made to have a different functional monomer on a surface thereof, thereby adding particles with a different surface functionality which associates with a respective charge control agent in the dielectric fluid, thereby achieving the desired charge in the particles. Nowhere does Hou teach or suggest an image display medium that includes therein at least two kinds of particles wherein a charge controller is internally added to one or both of the particles.

During the interview, Examiner Patel indicated that the present application is unclear as to the charge controller and the manner in which it is internally added. Applicants direct Examiner Patel to page 10, lines 12-20 for characteristics of the charge controller recited in claim 1. Further, pages 19-20 of the specification describe one example by which the charge controller is internally added to a particle as recited in claim 1.

Claim 1 of the present application specifically recites "a charge controller is internally added to one or both of the particles". By internally adding the charge controller, problems such as lowering of the charged amount by the transfer of the fine particles to the mating particles, and transfer to the transparent electrode substrate and lowering of the display contrast due to the change of the powder flowability, are avoided. See page 8, lines 4-9 of the specification.

The charge controller being internally added to one or both of the particles as recited in claim 1 is clearly different than Hou's disclosure.

Therefore, Hou does not teach or suggest a charge controller that is internally added as in the recited claims 1-4 and 9. Reconsideration and withdrawal of the rejection are thus respectfully requested.

II. Rejection Under 35 U.S.C. §103(a)

Claims 5-8 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hou in view of U.S. Patent No. 5,411,398 (hereinafter Nakanishi). This rejection is respectfully traversed.

The Patent Office asserts that Hou discloses a pair of facing substrates, and at least two particles, each having a single color. However, the Patent Office does admit that Hou does not teach a non-magnetic particle having frictional chargeability. The Patent Office claims that Nakanishi shows a non-magnetic particle having frictional chargeability.

Contrary to the Patent Office's assertion, the suggested combination would not have been made by one of ordinary skill in the art as no suggestion is made in either Hou or Nakanishi for combining these references. Nakanishi teaches a magnetic display system wherein a magnet causes the shift of the magnetic particles toward the back surface of the display while the non-magnetic particles shift toward the front surface of the display. Hou does not utilize a magnetic system, and thus one would not have been motivated to remove only the non-magnetic particles described in Nakanishi for use in Hou for any reason. The selective picking and choosing of Nakanishi's non-magnetic particles in the Office Action is clearly based solely on improper hindsight.

Further, Nakanishi alone does not teach or suggest present claim 5 as Nakanishi uses magnetization instead of positively and negatively charged particles.

Therefore, Applicants believe that claims 5-8 are allowable. Reconsideration and withdrawal of the rejection are thus respectfully requested.

III. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-9 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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Date: July 29, 2004

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